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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/727,554      | 12/04/2000  | Masahiro Arai        | 040679/1173         | 4320             |

22428 7590 03/23/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

CORRIGAN, JAIME W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3748

DATE MAILED: 03/23/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/727,554

Applicant(s)

ARAI ET AL.

Examiner

Jaime W Corrigan

Art Unit

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4 and 6-8 is/are allowed.
- 6) ☒ Claim(s) 1, 5, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 17.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office Action is in response to the Request for Reconsideration filed on 30 December 2003. Overall, claims 1-10 are pending in this application. The arguments with respect to the references applied in the previous Office Action were deemed persuasive, however, a new Non-final rejection is set forth below.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The use of the terms "damping" and "dampened" in claims 1, 7-8 to mean "the engine torque gradually rises or falls, in a manner which is neither step-like nor ramp-like, from a first level to a second level at which the response plateaus" as alleged in Applicant's response received 30 December 2003 is indefinite. The originally filed disclosure finds no support for such an interpretation. The accepted meaning of the word(s) damping and dampened, is "diminish activity", "a dulling or deadening effect". Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakamoto et al. (PN 5,222,465).

Regarding claims 1, 5 Sakamoto discloses a method for controlling intake air (See Column 2 Lines 47-64) of an internal combustion engine, the engine having at least one combustion chamber (See Figure 1 (3A)) provided with an intake valve (See Figure 1 (7)) together with an intake manifold (See Figure 1 (5)) provided with a throttle valve (See Figure 1 (10)), wherein the opening and closure timings of the intake valve are adjustable (See Figure 1 (37)) Column 1 Lines 8-12) independently from a crankshaft position to control the amount of intake air (See Column 2 Lines 47-64, Column 6 Lines 32-35, Lines 48-67) supplied to the combustion chamber, the method comprising: damping (See Column 2 Lines 15-19, Column 8 Lines 45-52, Column 9 Lines 15-19) an operating signal for the intake valve relative to a change in acceleration or deceleration (See Column 2 Lines 15-19, Column 9 Lines 15-19) demand on the engine, for unthrottled (See Figure 4, Column 6 Lines 52-59) intake air control.

Regarding claim 9 Sakamoto discloses the operating signal is for timing

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the opening and closing of the intake valve (See Figure 3, Column 5 Lines 41-68, Column 10 Lines 15-22).

Regarding claim 10 Sakamoto discloses the operating signal is for regulating the air intake (See Figure 4, Figure 5 (S2), Column 6 Lines 32-35) into the combustion chamber.

***Allowable Subject Matter***

Claims 2-4, 6-8 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 5, 9-10 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato et al. (PN 5,590,632), Russell et al. (PN 6,182,636), Aoyama (PN 4,357,917), Asmus (PN 4,633,403), Sapienza, IV et al. (PN 4,878,461), Simko et al. (PN 5,161,497), Nelson et al. (PN 4,917,058) disclose similar timing devices.

Any inquiry concerning this communication from the examiner should be directed to Examiner Jaime Corrigan whose telephone number is (703) 308-2639. The

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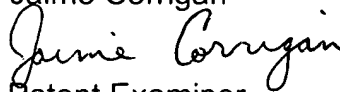
examiner can normally be reached on Monday - Friday from 8:30 a.m. – 6:00 p.m. 2<sup>nd</sup>  
Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reached on (703) 308-2623. The fax number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.


JC

Jaime Corrigan

  
Patent Examiner

March 17, 2004

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**THOMAS DENION**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**